

REMARKS

The Office Action mailed December 30, 2004 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-6 are pending in this application. Claims 7-20 have been canceled.

The rejection of Claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Lemelson (U.S. Pat. No. 4,733,049) is respectfully traversed.

Lemelson describe an automatic tool inspection and detection system 10 used for inspecting machining heat softenable materials. System 10 includes a controller 11 that controls operation of a machine tool 14. An inspection probe 22 is coupled to tool 14 and includes an extendable and rotatable arm 21. A plurality of transducers 26-28 are coupled to arm 21 to sense surfaces which are normal to the axis of rotation of cutting tool 14T. Notably, Lemelson does not describe nor suggest using an inspection tool to inspect the component while coupled to the fixture, wherein the inspection tool includes a probe having at least a first and a second probe tip that are each selectively positionable with respect to each other. Moreover, Lemelson does not describe nor suggest a means for securely coupling a component to be inspected in position during machining of the component.

Claim 1 recites a method for inspecting a component, wherein the method comprises "coupling the component to a fixture such that the component is fixedly secured in position during machining of the component...and inspecting the component using an inspection tool while the component is coupled to the fixture, wherein the inspection tool includes a probe having at least a first and a second probe tip that are each selectively positionable with respect to each other."

Lemelson does not describe nor suggest a method for inspecting a component as is recited in Claim 1. More specifically, Lemelson does not describe nor suggest a means for securely coupling a component to be inspected in position during machining of the component. Moreover, Lemelson does not describe nor suggest using an inspection tool to inspect the component while coupled to the fixture, wherein the inspection tool includes a probe having at least a first and a second probe tip that are each selectively positionable with respect to each other. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Lemelson.

Claims 2 and 3 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 2 and 3 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2 and 3 likewise are patentable over Lemelson.

For at least the reasons set forth above, Applicants respectfully request that the Section 102 rejection of Claims 1-3 be withdrawn.

The rejection of Claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Lemelson is respectfully traversed.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, the mere assertion that it would have been obvious to one of ordinary skill in the art to have modified Lemelson to obtain the claimed recitations of the present invention does not support a prima facie obvious rejection. Rather, each allegation of what would have been an obvious matter of design choice must always be supported by citation to some reference work recognized as standard in the pertinent art and the Applicants given the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. Applicants have not been provided with the citation to any reference supporting the combination made in the rejection. The rejection, therefore, fails to provide the Applicants with a fair opportunity to respond to the rejection, and fails to provide the Applicants with the opportunity to challenge the correctness of the rejection.

Moreover, obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify Lemelson. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant." In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Furthermore, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne

cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants’ disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants’ disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to modify the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 4-6 be withdrawn.

Moreover, Lemelson does not describe nor suggest a method for inspecting a component as is recited in the Claims of the present invention. Specifically, Claims 4-6 depend from Claim 1 which recites a method for inspecting a component, wherein the method comprises “coupling the component to a fixture such that the component is fixedly secured in position during machining of the component...and inspecting the component using an inspection tool while the component is coupled to the fixture, wherein the inspection tool includes a probe having at least a first and a second probe tip that are each selectively positionable with respect to each other.”

Lemelson does not describe nor suggest a method for inspecting a component as is recited in Claim 1. More specifically, Lemelson does not describe nor suggest a means for securely coupling a component to be inspected in position during machining of the component. Moreover, Lemelson does not describe nor suggest using an inspection tool to inspect the component while coupled to the fixture, wherein the inspection tool includes a probe having at least a first and a second probe tip that are each selectively positionable with respect to each other. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Lemelson.

Claims 4-6 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 4-6 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 4-6 likewise are patentable over Lemelson.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 4-6 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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